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MATTINGLY, STANGER, MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA VA 22314

In re Application of: Kanai
Application No. 10/771,465
Filed: February 5, 2004
For: STORAGE DEVICE CONTROLLING
DEVICE AND CONTROL METHOD FOR
STORAGE DEVICE CONTROLLING
DEVICE

TO MAKE SPECIAL
(ACCELERATED
EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)
DECISION ON PETITION

This is a response to the petition filed November 10, 2004, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in **37 CFR 1.17(h)**;
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-

examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, petitioner will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in regular turn. In those instances where a request is defective in one or more respects, petitioner will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

The petition filed November 10, 2004 fails to adequately meet requirement (e) of the criteria set forth above. With respect to requirement (e), applicant must provide a detailed discussion of the reference documents. The applicant merely paraphrase one or two paragraphs of each reference (as in the discussion of U.S. Publication No. 2003/0023784, **which paraphrases the first sentence of section 0037**) accompanied by a single statement that the references do not include certain features of the claimed invention. The applicant should also discuss each independent claim in view of the references cited. For example, the applicant merely glazes over claim 1 and the Chilton reference as if the features of claim 1 are included in all of the claims and the features of the Chilton reference are the only features taught by the other references. However, the feature “wherein the second processor transmits information indicating the storage position of the data in the second memory **to the first processor**” has not been set forth in claim 3; the data specified in the quoted portion directly above appears to be “data transfer information” in claim 4; and the feature in which “the first processor writes into the third memory data transfer information containing information indicating the storage position of the data in the first memory **and information indicating the storage position of the data in the second memory**” and the feature in which “the data transfer device reads out the data transfer information from the third memory **and controls the data transfer information**”, has not been set forth in claim 6. Petitioner should ensure that the above discussion is directed to how the language of **each of the independent claims** is specifically distinguishable and patentable from the references provided in requirement (d) above. The statement that the references shares the same deficiencies as another reference is not sufficient to meet the requirement of a detailed discussion as required by 37 CFR 1.111 (b) and (c).


The submission does not satisfy the requirement, as it does not provide a **detailed discussion** of the references and it does not point out how the **claimed subject matter is patentable of the references**. Petitioner should ensure that the above discussion is directed to how the language of

each of the independent claims is specifically distinguishable and patentable from the references provided in requirement (d) above.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



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